

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BARRY L. RAUWORTH and JOHN HENNEN

MAILED

JUN 30 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-1227
Application No. 09/960,606

HEARD: JUNE 8, 2006

Before OWENS, CRAWFORD, and LEVY, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 15, which are all of the claims pending in this application. Claim 16 has been cancelled.

The appellants' invention relates to a blow molded drum (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hammes	4,228,122	Oct. 14, 1980
Przytulla	4,925,049	May 15, 1990
McKenzie	5,199,570	Apr. 6, 1993

Admitted prior art shown in Figure 5

THE REJECTIONS

Claims 1 to 15 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement.

Claims 1 to 3, 6, 7 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over McKenzie in view of Przytulla and Hammes.

Claims 4, 5, 8, 9 and 11 to 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over McKenzie in view of Przytulla and Hammes and further in view of the admitted prior art within this application.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants' regarding the above-noted rejections, we make reference to the answer (mailed November 8, 2004) and for the examiner's complete reasoning in support of the

rejections, and to the brief (filed August 20, 2004) and reply brief (filed December 27, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 1 to 15 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. We note that the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The examiner states that there is no support for the recitation "single blow molding operation" of claim 1.

The appellants argue that the aspect of a single blow molding operation is adequately described in the U. S. Patent No. 4,228,122 to Hammes, the disclosure of which is incorporated by reference into the instant disclosure on page 7 of appellants' specification.

While the examiner recognizes that the disclosure of Hammes is incorporated by reference and must be examined to determine whether the subject matter of the claim is described so as to comply with the first paragraph of 35 U.S.C. § 112, the examiner is of the opinion that Hammes does not disclose that there is only one single blow molding operation.

Hammes discloses:

. . . the thermoplastic parison or tubular member is blown in a mold to form a closed head drum and during this operation an intermediate form of the roller chimes is produced and, *after the blowing operation*, movable parts of the mold are displaced. (emphasis added) (col. 2, lines 22 to 26).

We agree with the appellants that this disclosure makes it clear that there is only one blow molding operation. Therefore, we will not sustain this rejection.

We turn next to the examiner's rejection of claims 1 to 3, 6, 7 and 10 under 35 U.S.C. § 103 as being unpatentable over McKenzie in view of Przytulla and Hammes. The examiner is of the opinion that McKenzie describes the invention as claimed except that McKenzie does not describe the cylindrical side wall and the one-piece integrally molded structure molded in a single blow molding operation. The examiner

relies on Przytulla and Hammes for disclosing a cylindrical side wall and a one-piece integrally molded structure molded in a single blow molding operation. The examiner concludes:

It would have been obvious to modify the shape of the side wall to be cylindrical as a matter of design choice in sacrificing the packing efficiency of rectangular in cross section side walls for cylindrical side walls which have less corner surfaces on their interior allowing faster and easier cleaning. It would have been obvious to blow mold the structure into one-piece in a single operation as a matter of design choice to take advantage of a design requiring no assembly of separate parts and a design which can be manufactured in a single operation eliminating multiple stages of manufacturing requiring storage, part inventories and multiple machines to perform each stage of manufacturing [final rejection at page 4].

We note that when it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the

gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). In determining obviousness/nonobviousness, an invention must be considered "as a whole," 35 U.S.C. § 103, and claims must be considered in their entirety. Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In the present case, we do not find motivation to combine the teachings of McKenzie with the teachings of Przytulla and Hammes. Instead, we agree with the appellants that as McKenzie discloses that it is advantageous to separately form the sleeve 40 (col. 5, lines 33 to 37). Therefore, there would be no motivation to form the body 11 and sleeve having a body, top and bottom structure integrally molded in a single blow molding operation. In addition, we do not find that there is motivation to modify the McKenzie device so as to have cylindrical walls as McKenzie specifically discloses that the shape and configuration on the containers promote stacking of nine containers on a conventional 48 inch X 42 inch pallet and provides a stable structure which can be readily handled, lifted and stacked (col. 5, lines 38 to 48).

In view of the foregoing, we will not sustain this rejection.

We will likewise not support the examiner's rejection of claims 4, 5, 8, 9 and 11 to 15 under 35 U.S.C. § 103 as this rejection also relies on the combination of McKenzie and Przytulla and Hammes.

The decision of the examiner is reversed.

REVERSED

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

STUART S. LEVY *J*
Administrative Patent Judge

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Patterson, Thuente, Skaar & Christensen
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402-2100

MEC/ki